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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,124	04/20/2007	Klaus Kulper	101769-370 KGB	4140
27384	7590	07/21/2010		
Briscoe, Kurt G. Norris McLaughlin & Marcus, PA 875 Third Avenue, 8th Floor New York, NY 10022			EXAMINER HUANG, CHENG YUAN	
			ART UNIT	PAPER NUMBER
			1787	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/590,124	<b>Applicant(s)</b> KULPER ET AL.	
	<b>Examiner</b> CHENG HUANG	<b>Art Unit</b> 1787	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 June 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 9-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 13-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08 June 2010 has been entered.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 13 is unclear as to whether there is only one laminating adhesive joining the separate layers or there is a laminating adhesive in-between the separate layers A, B, and C.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 1787

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 and 3-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Terry et al. (U.S. Patent Application Publication No. 2005/0180704).

7. Regarding claim 1, Terry et al. teaches a tape for bandaging cable harnesses (See Abstract), comprising a backing with a first outer layer A inherently having a first side (support 16, paragraph [0032]), wherein the first side of the first outer layer A connected to a separate second layer C (open layer 10', paragraph [0032]) over the entire area of the first side of the outer layer A (Fig. 4), the outer layer A being composed of a scrim or woven fabric (paragraph [0039]), and the layer C being composed of a textile having an open but stable three-dimensional structure (paragraphs [0033] and [0034]).

8. While there is no disclosure that the tape is abrasion-resistant and noise-suppressing as presently claimed, applicants attention is drawn to MPEP 2111.02 which states that "if the body of a claim fully and intrinsically sets forth all the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction". Further, MPEP 2111.02 states that statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the purpose or intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

Art Unit: 1787

9. It is the examiner's position that the preamble does not state any distinct definition of any of the claimed invention's limitations and further that the purpose or intended use, i.e. abrasion-resistant and noise-suppressing, recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art invention and further that the prior art structure which is a tape identical to that set forth in the present claims is capable of performing the recited purpose or intended use.

10. Regarding claim 3, given that Terry et al. teaches wherein first outer layer A comprises polyester (paragraph [0033]) and layer C comprises polyester or propylene (paragraph [0041]) which are materials identical to those of the presently claimed invention, it is expected that the backing of Terry et al. inherently possesses the abrasion resistance of the presently claimed invention.

11. Regarding claim 4, Terry et al. teaches wherein the layer C is a three-dimensional nonwoven structure (paragraphs [0033] and [0034]).

12. Regarding claim 5, Terry et al. teaches wherein the layer C has a thickness of 0.1 to 6 mm (paragraph [0033]).

### ***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1787

14. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

15. Claims 2, 6-8, and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Terry et al. (U.S. Patent Application Publication No. 2005/0180704).

16. Terry et al. is relied upon as disclosed above.

17. Regarding claim 2, Terry et al. does not explicitly teach wherein the layer C is firmly connected on an open side to a second separate outer layer B over the entire area of a first side of the outer layer B, wherein the outer layer B is composed of a velour, scrim, woven fabric or formed-loop knit.

18. However, Terry et al. teaches a support layer composed of woven fabric or scrim (paragraph [0039]). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a support layer on open layer 10' for added protection or mechanical strength. The duplication of parts is generally recognized as being within the level of ordinary skill in the art, absent unexpected results. Providing a second support would have achieved expected results such as protection or mechanical strength. Mere duplication of parts has no patentable significance unless a new and unexpected result is produced. MPEP 2144.04 (VI) B. *In re Harza*, 124 USPQ 378, 380 (CCPA 1960). The resulting structure of Terry et al. teaches

Art Unit: 1787

wherein the layer C is firmly connected on an open side to the second separate outer layer B over the entire area of a first side of the outer layer B.

19. Regarding claim 6, the resulting structure of Terry et al. teaches further comprising a mechanical bond formation joining, without adhesive, the separate layers A, B and C to form an assembly (paragraph [0049]).

20. Regarding claim 7, the resulting structure of Terry et al. teaches wherein the layers A, B, and C comprise wear-resistant polymers (paragraphs [0033] and [0041]) given that the presently claimed invention discloses that wear-resistant polymers include polyesters and polyolefins (paragraph [0048]).

21. Regarding claim 8, Terry et al. teaches wherein the backing is coated at least on one side with a self-adhesive layer (adhesive 22, paragraph [0045]), wherein the layer C intrinsically has a thickness defined between a first side and a second side opposite to the first side.

22. Terry et al. does not explicitly teach wherein the entire thickness of layer C is located between the first side of the layer A and the self-adhesive layer.

23. However, Terry et al. teaches a self-adhesive layer (adhesive 22, paragraph [0045]). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide an adhesive layer on open layer 10' for added adhesion. The duplication of parts is generally recognized as being within the level of ordinary skill in the art, absent unexpected results.

Providing a second adhesive would have achieved expected results such as adhesion. Mere duplication of parts has no patentable significance unless a new and unexpected result is produced. MPEP 2144.04 (VI) B. *In re Harza*, 124 USPQ 378, 380 (CCPA 1960). The resulting

Art Unit: 1787

structure of Terry et al. teaches wherein the entire thickness of layer C is located between the first side of the layer A and the self-adhesive layer.

24. Regarding claim 13, the resulting structure of Terry et al. teaches further comprising a laminating adhesive joining the separate layers A, B and C to form an assembly (adhesive 22, paragraph [0045]).

25. Regarding claim 14, the resulting structure of Terry et al. teaches wherein the self-adhesive layer is made of an acrylate adhesive (paragraph [0046]).

### ***Response to Arguments***

26. Applicant's arguments, filed 08 June 2010, with respect to the rejection(s) of claim(s) 1-8 and 13-14 under 35 U.S.C. 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Terry et al.

### ***Conclusion***

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHENG YUAN HUANG whose telephone number is (571) 270-7387. The examiner can normally be reached on Monday-Thursday from 8 AM to 4 PM.

28. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho, can be reached at 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 1787

29. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. H./

Cheng Yuan Huang

Examiner, Art Unit 1787

July 15, 2010

/Callie E. Shosho/

Supervisory Patent Examiner, Art Unit 1787